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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,478	03/09/2004	Angela Adams	031599/270573	2292
826	7590	07/20/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			KIM, SANG K	
			ART UNIT	PAPER NUMBER
			3654	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,478

Applicant(s)

ADAMS ET AL.

Examiner

SANG KIM

Art Unit

3654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-8 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-8 and 15 is/are rejected.
- 7) ☒ Claim(s) 14-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Objections***

Claims 13-14 are objected to because of the following informalities: In claim 13, "the outer tube and the inner tube" should be --the outer paperboard tube and the inner paperboard tube--. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Marshall et al., U.S. Patent No. 5469297.

Marshall '297 discloses a paper tube 10 comprising an inner paperboard tube 12 having a radially outer surface and a radially inner surface; an outer paperboard tube 40, 70 having a radially outer surface and a radially inner surface; the inner paperboard tube 12 coaxially disposed within the outer paperboard tube 40, 70 such that the radially outer surface of the inner paperboard tube 12 forms an interface with the radially inner surface of the outer paperboard tube 40, 70; the interface being devoid of adhesive since it has a frictional fit and the inner paperboard tube being axially offset with respect to the outer paperboard tube 40, 70 such that one end 14 of the inner paperboard tube 12 projects beyond the outer paperboard tube 40, 70 and forms a male end of the core

and an opposite end of the outer paperboard tube 40, 70 projects beyond the inner paperboard tube and forms a female end of the core, see figure 3.

It has been held that the recitation that an element is "insertable" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Note, the proximal end 14 diameter of the inner paperboard tube 12 is smaller than the inner diameter of the outer paperboard tube 40, 70, which can be inserted into the female end of another same core of Marshall '297 to provide a stacking feature.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al., U.S. Patent No. 5469297.

As advanced above, Marshall '297 discloses applicant's claimed device except for explicitly showing another core stacking onto each other. However, Marshall '297 already shows the distal end 16 of the inner paperboard tube 12 inserted into the outer paperboard tube 40, 70, and explains that the plug 66 can be removed from the wall, see figure 3, and see column 3, lines 61-63.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the plug and add additional cores to provide a stacking feature to help organize or store the cores in a compact manner. Furthermore, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al., U.S. Patent No. 5469297, in view of Burnside III, U.S. Patent No. 3096681.

As advanced above, Marshall '297 discloses the inner paperboard tube 12 and the outer paperboard tube 40, 70 are made from wound paper, but does not explicitly explain if the wound paper is spirally wound tube.

Burnside '681 discloses the tubes 9 and 10 are made of spiral wound and glued layers, see column 2, lines 44-48.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tubes of spiral wound and glued layers as taught by Burnside '681, to provide stiffness and strength to the tubes.

#### ***Allowable Subject Matter***

Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Claims 1-3 and 9-12 have been canceled.

Claims 13-15 have been added.

Claims 4-8 have been amended.

Applicant's arguments with respect to claims 4-8 have been considered but are moot in view of the new ground(s) of rejection.

The added recitation that the interface being devoid of adhesive and the inner paperboard tube being axially offset with respect to the outer paperboard tube to form a male end and the outer paperboard tube projecting beyond the other end of the inner paperboard tube to form a female end necessitated the new grounds of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

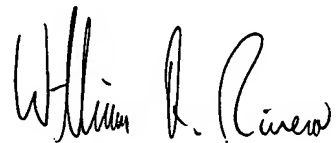
Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANG KIM whose telephone number is 571-272-6947. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:30 P.M. alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki, can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SK

7/10/06

A handwritten signature in black ink, appearing to read 'William A. Rivera', is written above the printed name.

**WILLIAM A. RIVERA  
PRIMARY EXAMINER**